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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/029,766	12/18/2001	Adrian Crisan	1662-55100 JMH (P01-3806)	4713

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EXAMINER	
ROMANO, JOHN J	
ART UNIT	**PAPER NUMBER**
2122	

DATE MAILED: 10/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/029,766	CRISAN ET AL.	
	Examiner	Art Unit	
	John J Romano	2122	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 December 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-27* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *18 December 2001* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claims **1-27** are pending in this action.

Drawings

1. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the drawings are not formal. Applicant is advised to employ the services of a competent patent draftsperson outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claim **1** is rejected under 35 U.S.C. 102(e) as being clearly anticipated by **Marsh**, Pub. No. US 2002/0073304.

3. In regard to claim **1**, **Marsh** discloses:

- "*A computer system, comprising:*

a CPU;..." (E.g., see Fig. 1 & Page 3, [0027]), wherein, the microprocessor is the CPU.

- *"...and a programmable read only memory ("ROM") coupled to said CPU..."* (E.g., see Fig. 1 & Page 1, [0007]), wherein, the non-volatile memory may be a EEPROM as disclosed in paragraph [0007] which is both erasable and programmable. Also, it is shown in Figure 1 that the ROM or non-volatile memory is coupled to the microprocessor.

- *"... said ROM containing a digital image; ..."* (E.g., see Fig. 1 & Page 2, [0013]), wherein, instructions from the programmable non-volatile memory or ROM are inherently a digital image; therefore the ROM contains a digital image.

- "*...wherein said CPU programs its ROM during system initialization.*" (E.g., see Fig. 4 & Page 5, [0048]), wherein, the flash application designated in the modified boot image, selected upon the next boot of the computer (system initialization), is erasing and then programming the non-volatile memory or ROM.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims **2, 3, 4, 6** and **7** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Marsh** and further in view of **Asco** et al., US 6,516,346, (hereinafter **Asco**) and **Naclerio** (US 6,502,240).

In regard to claim **2**, **Marsh** discloses "*The system of claim 1 including a connection to a network...*" (E.g., see Fig. 5 & Page 4, [0042]), wherein, the system of claim **1** is presented within a network configuration. But **Marsh** does not expressly disclose "*...said system sends a message to a server coupled to the network to determine whether an upgraded image is available for said ROM.*" However, **Asco** discloses:

- "*...said system sends a message to a server coupled to the network to determine whether an upgraded image is available for said ROM.*" (E.g., see Fig. 3 and Column 4, lines 26-56), wherein, the microcode is the upgraded BIOS image for a programmable ROM.

Marsh and **Asco** are analogous art because they are both concerned with the same field of endeavor, namely, a firmware upgrade via the Internet. Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify **Marsh's** method for updating firmware with **Asco's** invention. The motivation to do so would have been to further achieve **Asco's** objective of "...making the upgrade process more user friendly..." (Page 1, lines 43-44). Each individual user would not have to find and remember details of Internet address's for the microcode

supplier. This would save time and increase productivity by letting the individual user focus on other tasks.

Marsh and **Asco** disclose the system of claim **1** as described above. But **Marsh** and **Asco** do not expressly disclose *"...during initialization..."*. However **Naclerio** discloses:

- *"...during initialization..."* (E.g., Column 2, lines 60-66), wherein the system start-up is the initialization.

Naclerio, and the combined teaching of **Marsh** and **Asco,** are analogous art because they are both concerned with the same field of endeavor, namely, an automated method to update control software. Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the combined teaching method for updating software with **Naclerio's** invention. The motivation to do so would have been to further achieve **Marsh's** objective of "...avoiding manual intervention..." (Page 2, Paragraph [0013]), and **Asco's** objective as disclosed above in claim **2**. Furthermore, **Naclerio's** objective of alleviating time and cost consequences would be achieved by requesting the download upon system start-up.

6. In regard to claim **3**, **Marsh**, **Asco** and **Naclerio** disclose the system of claim **2** above. But in claim **2**, they did not disclose expressly "*...wherein, during initialization, said system receives an upgraded image and flashes said ROM with the upgraded image.*" However, **Marsh** discloses:

- "*...said system receives an upgraded image and flashes said ROM with the upgraded image.*" (E.g., see Fig. 6 and Page 5, Paragraph [0047] and

[0048]), wherein, the delivered firmware is the received upgraded image and the flash application flashes the ROM and installs the upgraded image.

Additionally, **Naclerio** discloses:

- "...*during initialization*..." (E.g., Column 2, lines 60-66), wherein the system start-up is the initialization as disclosed in claim **2** above. Furthermore, it would be obvious to one skilled in the art to implement the method of the system receiving the upgraded image, during initialization, in collaboration with sending the message during initialization.

7. In regard to claim **4**, claim **4** is rejected as a system of previously disclosed claims **2** and **3**. Claim **2** discloses the "...said server..." by teaching the network configuration. It is obvious to one skilled in the art that a server may be part of a network.

8. In regard to claim **6**, **Marsh, Asco** and **Naclerio** disclose the system of claim **2** above. But in claim **2**, they did not disclose expressly "...*wherein the message includes an indication of the version of the ROM's current image.*" However, **Asco** discloses:

- "...*wherein the message includes an indication of the version of the ROM's current image*." (E.g., see Fig. 3 & Column 1, lines 48-63), wherein, the microcode level is the version of the ROM's current image.

9. In regard to claim **7**, **Marsh, Asco** and **Naclerio** disclose the system of claim **2** above. But in claim **2**, they did not disclose expressly "...*wherein the message includes an indication of the class of the ROM.*" However, **Asco** discloses:

"...*wherein the message includes an indication of the an indication of the class of the ROM.*" (E.g., see Fig. 3 & Column 1, lines 48-63), wherein, the relevant hardware configuration is an indication of the class of the ROM.

10. Claim **5** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Marsh**, **Asco** and **Naclerio** as applied to claim **2** above, and further in view of **Martinez.**

11. In regard to claim **5**, **Marsh, Asco** and **Naclerio** disclose the system of claim **2** above. But in claim **2**, they did not disclose expressly "...*wherein said system receives a link to another server which provides the upgraded image.*" However, **Martinez** (US 6,594,757), discloses:

- "...*wherein said system receives a link to another server which provides the upgraded image.*" (E.g., see Fig. 3A & Column 2, line 65 – Column 3, line 2), wherein it would have been obvious to a person of ordinary skill in the art to store a web page on a server.

Martinez and the combined teachings of **Marsh**, **Asco** and **Naclerio,** are analogous art because they are both concerned with the same field of endeavor, namely, an upgradeable BIOS program. Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to implement **Martinez's** limitation into the combined teaching method for updating firmware. The motivation to do so would have been to further decrease manual intervention by simply providing the URL to an executable rather than manually downloading it to a pre-specified server. The advantages would be time and cost savings.

12. Claim **8** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Marsh**, **Asco** and **Naclerio** as applied to claim **2** above, and further in view of **Olarig** (US 6,009,524).

13. In regard to claim **8**, **Marsh, Asco** and **Naclerio** disclose the system of claim **2** above. But in claim **2**, they did not disclose expressly "*...wherein said message includes an encryption key to be used to help assure the authenticity of the image.*" However, **Olarig** discloses:

- "*...wherein said message includes an encryption key to be used to help assure the authenticity of the image.*" (E.g., see Fig. 2 & Column 4, lines 59-67), wherein, a dual-key digital-signature-verification system are used to assure authenticity.

Olarig and the combined teachings of **Marsh**, **Asco** and **Naclerio** are analogous art because they are both concerned with the same field of endeavor, namely, an upgradeable BIOS program. Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to implement **Olarig's** limitation into the combined teaching method for updating firmware. The motivation to do so would have been to assure authenticity of the BIOS program. Thereby, eliminating a tampered program that could have severe time and cost consequences in addition to security issues.

14. In regard to claim **9**, claim **9** is rejected as a method version of claims **1** and **2**. Correspondingly, **Marsh**, **Asco** and **Naclerio** disclose the limitations of claim **9** as described above in claims **1** and **2**. Thus the limitations are met for claim **9** as disclosed in the respective above claims.

15. Respectively, claims **10, 11, 12, 13, 14 and 15** are rejected as method versions of claims **3, 4, 5, 6, 8 and 7**. Likewise, the limitations of the aforementioned claims are disclosed as described in their corresponding claims. Thus, the limitations are met for claims **10, 11, 12, 13, 14 and 15**.

16. Claims **16,17** and **18** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Marsh** and further in view of **Asco**.

17. In regard to claim **16**, **Marsh** discloses "*A ROM image system...*" as disclosed in claim **1**, wherein the system of claim **1** is presented within a network configuration. But **Marsh** does not disclose expressly "*...a server; and a database accessible by said server, said database storing information regarding ROM images; wherein said server receives a message from computer to determine if an upgrade exists for the computer's ROM image, uses said information to determine if an upgrade is available for the computer's ROM image and transmits a message to the computer indicating whether an upgrade is available.*" However, **Asco** discloses:

- "*...comprising: a server; and a database accessible by said server, said database storing information regarding ROM images; wherein said server receives a message from computer to determine if an upgrade exists for the*

computer's ROM image, uses said information to determine if an upgrade is available for the computer's ROM image and transmits a message to the computer indicating whether an upgrade is available." (E.g., see Figure 2 & Column 1 lines 45 - 63), wherein the remote system is the server and the database associated with the remote system contains current microcode level and configuration information regarding the computer's ROM image. The notification to the computer system is the message indicating that an updated image is available.

18. In regard to claim **17**, **Marsh** and **Asco** disclose the method of claim **16** as explained above. But, in the above claim **Marsh** and **Asco** do not expressly disclose "*...said response includes an upgraded ROM image.*" However, **Asco** does expressly disclose:

- "*...said response includes an upgraded ROM image.*" (E.g., see page 1, lines 60 – 62), wherein the more recent microcode level is the upgraded ROM image.

19. In regard to claim **18, Marsh** and **Asco** disclose the method of claim **16** as explained above. But, in the above claim **Marsh** and **Asco** do not expressly disclose "*...said response includes a pointer to where an upgraded image is located.*" However, **Asco** does disclose:

- "...*said response includes a pointer to where an upgraded image is located.*" (E.g., see Figure 1 & Column 2, lines 23-27), wherein, the Internet address is a pointer to where an upgraded image is located.

20. Claim **19** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Marsh** and **Asco** and further in view of **Martinez**, as discussed above.

21. In regard to claim **19**, **Marsh** and **Asco** disclose the method of claim **16** as explained above. But, in the above claim **Marsh** and **Asco** do not expressly disclose "...said pointer includes a URL." However, **Martinez** does expressly disclose:

- "...*said pointer includes a URL.*" (E.g., see Figure 3A & Column 2, line 65 – Column 3, line 2), wherein the retrieved page is a pointer which includes a URL.

22. Claim **20** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Marsh, Asco** and **Martinez**, as described above, and further in view of **obviousness.**

23. In regard to claim **20, Marsh**, **Asco** and **Martinez** disclose the method of claim **18** as explained above. But, in the above claim, **Marsh**, **Asco** and **Martinez** do not expressly disclose "...*said pointer includes an IP address.*" However, it is well known to one of ordinary skill in the art that an Internet Address is an IP address that uniquely identifies a node on an internet. Thus, **Asco** discloses:

- "...*said pointer includes an IP address.*" (E.g., see Column 2, lines 23 - 27), wherein, the Internet Address is a pointer, which includes an IP address.

24. Claim **21** is rejected as a method version of the system of the previously disclosed claim **16**. Thus, the limitations of claim **21** are met as described in claim **16**.

25. Claim **22** is rejected as a method version of the system of the previously disclosed claim **17**. Thus, the limitations of claim **22** are met as described in claim **17.**

26. Claim **23** and **24** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Marsh, Asco** and **Martinez**, as described above, and further in view of **Asco.**

27. In regard to claim **23, Marsh**, **Asco** and **Martinez** disclose the method of claim **18** as explained above. But, in the above claim **Marsh** and **Asco** do not expressly disclose "...*a link*..." However, **Asco** does disclose:

- "...a link..." (E.g., see Figure 3 & Column 4, lines 50 – 54), wherein hyperlink is a link.

28. In regard to claim **24**, **Marsh** and **Asco** disclose the method of claim **18** as explained above. But, in the above claim **Marsh** and **Asco** do not expressly disclose "...the link includes a URL." However, **Martinez** does expressly disclose:

- "...*the link includes a URL.*" (E.g., see Figure 3 & Column 2, line 65 – Column 3, line 2), wherein the retrieved page is a link which includes a URL.

29. Claims **25** and **26** are method versions of the system of the previously disclosed claims **19** and **20**. Thus, the limitations of claims **25** and **26** are met, respectively, as described in claims **19** and **20**.

30. In regard to claim **27**, claim **27** encompasses some limitations from claim **16** and claim **2**, and also includes further limitations disclosed by **Asco**. Claim **2** discloses a computer having a programmable ROM coupled to a server communicating with a network, during initialization. Claim **16** discloses a request to a server, including storage for a ROM image, and a computer requesting a ROM image update from the said server. But the aforementioned claims do not expressly disclose: "... *a proxy enterprise ROM server to which the computers couple, said proxy enterprise ROM server communicating with a network external to the enterprise...*" or "...*a plurality of computers...*". However, **Asco** discloses:

- "... *a proxy enterprise ROM server to which the computers couple, said proxy enterprise ROM server communicating with a network external to the enterprise...*" and "...*a plurality of computers...*". (E.g., see Figure 2 & Column 2, line 64 – Column 3, line 10), wherein, a proxy server to which computers are coupled is the enterprise ROM server. A wide are data processing network comprising a local network connected via the Internet is interpreted as an enterprise computing system comprising a plurality of computers.

Conclusion

31. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. **Griffioen** et al., US 2002/0188934.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J Romano whose telephone number is (703) 305-0358. The examiner can normally be reached on 8-5:30, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q Dam can be reached on (703) 305-4552. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chameli C Das
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PRIMARY EXAMINER
10/18/06.